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In re Patent No. 8,803,189	:	
Issue Date: August 12, 2014	:	DECISION DENYING REQUEST
Application No. 12/538,701	:	FOR REDETERMINATION OF
Filing or 371(c) Date: August 10, 2009	:	PATENT TERM ADJUSTMENT
Attorney Docket No. TSM08-0322	:	

This is in response to patentee's "APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705" filed August 21, 2014, which is being treated under 37 CFR 1.705(b) as a request that the Office correct the patent term adjustment determination ("PTA") from 449 days to 574 days.

The request is **DENIED**.

This redetermination of patent term adjustment is the Director's decision on patentee's request for reconsideration within the meaning of 35 U.S.C. 154(b)(4) that triggers a 180-day period for applicant disagreeing with the Office redetermination to commence a civil action in the District Court for the Eastern District of Virginia.

Relevant Procedural History

On August 12, 2014, this patent issued with a PTA of 449 days. On August 21, 2014, patentee timely filed the present request for redetermination of patent term adjustment within two months of the issue date of the patent.

Patentee seeks 574 days of PTA. Patentee solely disputes the calculation of "B" delay. Patentee requests 125 days of "B" delay based on the Federal Circuit's interpretation of 35 U.S.C. § 154(b)(1)(B) set forth in *Novartis AG v. Lee,* No. 2013-1160 (Fed. Cir. Jan. 15, 2014). Patentee calculates the period of "B" delay as follows:

> Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b) as modified by the Federal Circuit's decision in *Novartis,* a delay of 125 days *(e.g.,* the period between August 10, 2012 *(e.g.,* the day after three years after the filing date listed in paragraph 1) and August 12, 2014 *(e.g.,* the issue date listed in paragraph 22), but excluding the period between February 16, 2012 *(e.g.,* the filing date of the Request for Continued Examination listed in paragraph 9) and April 8, 2014 *(e.g.,* the mailing

> date of the Notice of Allowance listed in paragraph 20)). Before *Novartis,* the Office excluded the period between April 8, 2014 and August 12, 2014 in the calculation of delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702(b) and 1.703(b).

Request, 08/21/14, p. 3.

Decision

The Office has carefully considered patentee's arguments. Upon review, the Office finds that patentee is entitled to **449** days of PTA. The Office and patentee are in agreement regarding the calculation of 449 days of "A" delay, 0 days of "C" delay, 0 days of overlap, and 0 days of applicant delay. The Office has revisited the determination of the amount of "B" delay in view of the Federal Circuit's decision in *Novartis AG v. Lee*, 740 F.3d 593 (Fed. Cir. 2014).

As to the amount of "B" delay, the Office notes that the interpretation of the "B" delay was based upon 37 CFR 1.703(b)(1) which excluded from the amount of "B" delay the period beginning on the date of filing of the continued examination and ending on the date of the issuance of the patent. However, the Federal Circuit reviewed the statutory interpretation of 35 U.S.C. § 154(b)(1)(B)(i) and issued a decision regarding the effects of a Request for Continued Examination ("RCE") on "B" delay in the *Novartis* appeal. In *Novartis*, the Federal Circuit agreed with the Office that "no ["B" delay] adjustment time is available for any time in continued examination, even if the continued examination was initiated more than three calendar years after the application's filing." *Novartis*, 740 F.3d at 601. However, the *Novartis* court found that if the Office issues a notice of allowance after an RCE is filed, the period after the notice of allowance should not be excluded from the "B" delay period but should be counted as "B" delay. *Id.* at 602. The Federal Circuit issued its mandate in the *Novartis* appeal on March 10, 2014.

Pursuant to the *Novartis* decision, the USPTO has determined patentee is entitled to zero (0) days of "B" delay. In this case, applicant filed the application on August 10, 2009, and the patent issued on August 12, 2014. Thus, the application was pending for 1829 days. During this time, applicant filed the first RCE on February 16, 2012. The Office mailed a Notice of Allowance on April 8, 2014. Under 35 U.S.C. § 154(b)(1)(B)(i), the time period consumed by continued examination ("RCE period") began on February 16, 2012, and ended on April 8, 2014 – *i.e.*, 783 days. Subtracting the RCE period from the total number of days the application was pending results in 1829 – 783 = 1046 days. Thus, for purposes of "B" delay, the application was pending for 1046 – 1097 [i.e., 3 years (including a leap year) from the actual filing date] = 0 days beyond the three-year anniversary of the filing date.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

USPTO's Calculation:

449 + 0 + 0 – 0 – 0 = 449

Patentee's Calculation

449 + 125 + 0 – 0 – 0 = 574

Conclusion

The Office affirms that patentee is entitled to PTA of four hundred forty-nine (449) days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: 449 + 0 + 0 – 0 – 0 = 449 days. A correction of the determination of patent term adjustment under 35 U.S.C. § 154(b) to 574 days is not merited. As the front page of the patent properly reflects the PTA determination of 449 days, no further action is required. Accordingly, the request for redetermination of patent term adjustment is **denied**. This decision may be viewed as a final agency action. See MPEP 1002.02(b).

The Office acknowledges receipt of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Attorney Advisor at (571) 272-3211.

/JOHN COTTINGHAM/
Director
Office of Petitions